REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application. Claims 6-13 are currently pending in this application. Claims 1-5 have been cancelled. No new matter has been added by way of the present amendment. For instance, the amendments to claims 6-9 are supported by previously presented claims 2-5, and are further supported by the Specification at, for example, page 12, lines 29-31, and page 13, lines 1-30. Newly added claim 10 is supported by the Specification at, for example, page 13, lines 28-30. Similarly, new claims 11-13 find support at page 18, lines 4-12. Accordingly, no new matter has been added.

In view of the amendments and remarks herein, Applicant respectfully requests that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

Issues Under 35 U.S.C. §103(a)

Claims 1-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fukushima et al. (U.S. 6,295,086) (hereinafter Fukushima '086) in view of Monroe et al. (U.S. 7,197,228) (hereinafter Monroe '228). Applicant respectfully traverses.

The Examiner asserts that Fukushima '086 discloses the use of an image capturing program that runs on a computer that also initiates playback of moving picture data off a digital VTR that had previously recorded onto itself a moving picture. The Examiner further asserts that Fukuyama '086 discloses a playback being displayed on a monitor in an image display window, wherein, based on the pressing of an image capturing key during playback, the current frame would be captured as a still image and be recorded. The Examiner notes that Fukuyama

'086 discloses that a captured image display window would be provided so that the user can distinguish between various still image files and that it would be displayed in sequential or random order, thus capturing operation of images. The Examiner asserts that it would have been obvious to one skilled in the art to modify Fukushima '086 in view of Monroe '228 due to "the desire to capture a sequential series of still images near an event, the example being a target being destroyed and capturing at the moment the target is identified to be hit where burst mode would help capture images of before the target was hit and during as well as after the hit".

As to claims 1-5, Applicant submits that these claims have been cancelled. Accordingly, the rejection of these claims is moot.

As to claims 6-9, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the "teaching, suggestion, motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* Rejections on obviousness grounds cannot be sustained by mere

conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

Initially, Applicant notes that neither Fukushima '086 nor Monroe '228 are directed to digital cameras. The Examiner is reminded that, to rely on a reference under 35 U.S.C. 103, the reference must be analogous art (see MPEP 2141.01(a)). Applicant submits that Fukushima '086 and Monroe '228 are directed to non-analogous art. For this reason alone, this rejection is improper and should be withdrawn.

Fukushima '086 discloses that, when a still picture extract command is input during playback of a moving picture data, still picture data at the moment of inputting the still picture extract command will be extracted from the moving picture data. However, while Fukushima '086 extracts only the still picture at the moment of inputting the still picture extract command, the present invention extracts still pictures at the moment of inputting, and immediately before, after, or before and after the moment the still picture extract command is input.

As shown by Figures 8B and 9 and discussed at pages 12-13 of the present Specification, when the menu/OK button 34 is pressed after selecting the "continuous shooting mode", the setting screen of the continuous shooting mode is displayed on the liquid crystal monitor 30 (see Figure 8B). On the setting screen, the setting of a segmentation condition, that is, "segmentation range", "number of segmented frames", and "segmentation interval" are set. The "segmentation range" is used in designating the range of segmenting a still picture by any of "immediately before", "immediately after", and "before and after". The "immediately before" is used in recording several frames immediately before a still picture extract command is issued. The "immediately after" is used in recording several frames immediately after an extract command is

issued. The "before and after" is used in recording several frames before and after an extract command is issued. When the settings of the segmentation condition are completed, the liquid crystal monitor 30 displays the editing screen for continuous shooting segmentation of still pictures (see Fig. 9). The moving pictures to be edited, the still pictures segmented from the moving pictures, the playback bar indicating the playback progress state, and the playback time are displayed on the still picture segmenting edit screen (see Fig. 9).

Fukushima '086 does not teach or suggest these features. Monroe '228 fails to cure the deficiencies of Fukushima '086.

Monroe '228 discloses a technology wherein a still picture is continuously extracted in specified time intervals when a period of time is designated during the recording of a moving picture. However, while Monroe '086 extracts the still picture in specific time intervals by designating a specific period of time, the present invention extracts images immediately before, after or before and after a **point of time** specifically designated (emphasis added). Monroe '228 does not designate a specific point of time nor does it extract still pictures immediately before, after or before and after that point of time.

Furthermore, as to newly added claims 10-13, Applicant submits that the cited references fail to teach or suggest the presently claimed still picture display area layouts. As described at page 18 of the present Specification, according to one embodiment of the present invention, three frames of images are extracted every 0.2 seconds from the moment when the menu/OK button 34 is pressed. According to another embodiment of the present invention, when five frames of images are extracted, as shown in Fig. 12, the "still picture display areas <1> to <5>" are provided for five frames above and on the right of the "moving picture display area". When

seven frames of images are extracted, as shown in Fig. 13, the "still picture display areas <1> to <7>" are provided for seven frames below and on both sides of the "moving picture display area". When three images are to be extracted, "still picture display areas <1> to <3>"can be provided for three frames on the right, as shown in Fig. 14. The cited prior art fails to teach or suggest the presently claimed display area layouts.

Clearly, the cited references fail to teach or suggest every limitation of the present invention. For this reason alone, this rejection is improper and should be withdrawn. Furthermore, Applicant submits that one skilled in the art would not be motivated to modify the teachings of these references as proposed by the Examiner.

Because the invention, as set forth in Applicant's claims, is not disclosed or made obvious by the cited prior art, reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Marc S. Weiner, Reg. No. 32,181

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By _____

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